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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,821	11/25/2003	Andreas Wicsmuller	1026-2	9368

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KENYON & KENYON LLP
1500 K Street NW
Washington, DC 20005

EXAMINER

LEVINE, ADAM L

ART UNIT	PAPER NUMBER
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3625

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



Office Action Summary

Application No.

10/722,821

Applicant(s)

WIESMULLER ET AL.

Examiner

Adam Levine

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicants' reply filed February 20, 2007, is responsive to the office action mailed September 19, 2006. The reply includes amendments to claims 1,3,9, and 11. The originally filed application contained 28 claims but omitted claim 25 and was therefore numbered 1-24 and 26-29. Claims 16-24 and 26-29 were previously withdrawn in response to a restriction requirement, election having been made without traverse. Claims 26-29 have been renumbered as claims 25-28 and therefore claims 16-28 have been withdrawn. Claims 1-15 are currently pending and examined in this office action.

Response to Amendment

Applicant has appointed an attorney or agent to conduct all business before the Patent and Trademark Office. Double correspondence with more than one attorney or agent will not be undertaken. Accordingly, applicant is required to conduct all future correspondence with this Office through the attorney or agent of record. See 37 CFR 1.33.

Pertaining to previous election/restrictions

This application contains claims 16-28, drawn to inventions nonelected without traverse in the reply filed on June 29, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Pertaining to drawing objections in the previous office action

Figs. 1-3 and 6-7 were objected to for the reasons indicated in the "Notice of Draftsperson's Patent Drawing Review," form PTO-948 attached to Paper #20060911. Replacement drawing sheets have been filed to address the reasons for objection and they appear to have been successful. The objections are withdrawn.

Pertaining to specification objections in the previous office action

The abstract of the disclosure was objected to because it exceeded 150 words in length. See MPEP § 608.01(b). This has been corrected and the objection is withdrawn.

Pertaining to claim objections in the previous office action

Claim 11 was objected to because of informalities. The claim has been amended as suggested and the objection is withdrawn.

Pertaining to claim rejections under 35 USC §112 in the previous office action

Claims 1,3, and 9 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims have been amended to provide corrected dependency and antecedent basis. The rejections are withdrawn.

Response to Arguments

Applicants' arguments filed February 20, 2007, have been fully considered but they are not persuasive. In response to applicant's argument that Hudda does not indicate what protocol is used to communicate with a user, but that it includes a variety

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and scope of function that likely requires a more complex interface not required by applicants' invention, it must be noted that the fact that Hudda discloses additional variety and scope of function not claimed is irrelevant. The applicants' claim includes both short message service (SMS) and multimedia message service (MMS) either together or in the alternative. Either could be used in Hudda to provide more limited functionality than potentially available. The complexity of the interface shown in Hudda does not preclude the use of SMS or MMS for communication with the user, and SMS and/or MMS were both well known communication options at the time of the invention. It is also noted that, while applicants' acknowledge Hudda discloses using SMS to notify a "buddy" of a purchase opportunity, applicants argue that "there is no indication that such messages can be used to provide commercial services to a user..." It is the examiner's position that notifying a "buddy" of a purchasing opportunity is a commercial service. Finally, it is noted that the features upon which applicant relies (i.e., using SMS and/or MMS messages to provide commercial services to a user) is not clearly recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Please see the list of references cited as relevant but not relied upon under "Conclusion" for various examples of the well known use of SMS/MMS messages in transactional systems and methods at the time of the invention.

With regard to applicants' remarks concerning goods versus services, the exact nature of the product itself is descriptive material and is not functionally involved in the

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recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106). Further it is the examiner's position that selection of grade and/or quantity is inherent in any art that concerns the selection and purchasing of goods or services. Hudda discloses selection of types and brands of product, for example, and discuss quantity of goods in a shopping basket. As described in the present application, selection of grade is synonymous with selection of type in Hudda. In fact, as described in the present application, the selection of grade is essentially the same as selection of the product itself, as in choosing between two different seat locations in a theatre. Although Hudda does not explicitly state that the user has selected a quantity, quantity must be chosen in order to complete the purchase. The fact that products are chosen, be they goods or services, means at the very least that a quantity has been selected, even if that quantity is one.

Election/Restrictions

This application contains claims 16-28, drawn to inventions nonelected without traverse in the reply filed on June 29, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hudda (Paper #20060911; US Pub.No.2001/0049636).

Hudda discloses all the limitations of claims 1-11 and 15. For example, Hudda discloses a data processing and communication method for providing commercial services over a wireless communication network to at least one user utilizing a mobile communication device configured for bi-directional communication over the wireless communication network with a service control system utilizing at least one of a short message service (SMS), or a multimedia message service (MMS) protocols. Hudda further discloses:

- at a service control system, receiving a selection of a service offered by a service provider: the service selected by at least one user in response to a trigger event, selecting by the at least one user, at least one service parameter for said service comprising at least one of grade of service and quantity of service, (see at least page 4 para.0066, page 7 para.0106-0109, 0113; page 8 para.0128-0130); service comprises at least one service selected from the following group: movies, concerts, cultural events (theater, opera, museums, performance art), sporting events, zoos, amusement parks, premium speaking engagements, travel tickets

(airline, train, bus, ship), car rentals, hotel rooms, and parking (Please note: In context of the method of the invention, the name of the service is descriptive material and is not functionally involved in the recited steps. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).

- confirming a purchase of said service by the at least one user: (see at least abstract, figs.3-5, page 10 para.0148)
- obtaining, by the service control system, payment for said service: from the at least one user (see at least abstract, page 5 para.0075, page 9-10 para.0143)
- transmitting a unique confirmation code: to the at least one user confirming purchase of said service (see at least figs.3, page 5 para.0075, 0079-0080); wherein the service control system communicates with the mobile device using at least one of a short message service (SMS) protocol and a multimedia message service (MMS) protocol (see at least page 10 para.0151); when the at least one user decides to claim said purchased service presenting said confirmation code by the at least one user to a service representative at a service claim location, verifying by the service representative using a local communication device communicating with said service control system the validity of said confirmation code, and if said confirmation code is valid providing the purchased service to the

user (see at least fig.3, page 3 para.0045, page 5 para.0075-0076,0079; page 9 para.0136).

- trigger event is at least one of the following steps: providing to the service control system by the user a keyword representative of at least one offered service, user searching said service system to locate desired offered service, transmitting by the service control system to the user an offer for offered service and accepting said offer by user, selecting at least one service option by said at least one user from said at least one service option, selecting of at least one default preference for said service program (see at least figs.4,6; page 4 para.0066, 0070-0072, page 7 para.0106-0109, 0113; page 8 para.0119,0128-0130, page 10 para.0147); subscribing, by the at least one user to a service program offered by said service provider, providing user information representative of the at least one user to the service control system (see at least figs.2-6, page 2 para.0019, page 5 para.0090, page 6 para.0100. Please note: providing representative user information as part of the subscription process is implied and inherent because in order for the user enrollment to have any meaning at all, the user must provide representative user information to the service control system); selecting of payment type by user such that payment is obtained utilizing one of said selected payment type (see at least abstract, page 2 para.0041, page 5 para.0075, page 9-10 para.0143); transmitting to the at least one user, information representative of said purchased service and instructions for claiming said purchased service (see at least figs.3, page 5 para.0075, page 5 para.0079-0080).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudda (Paper #20060911; US Pub.No.2001/0049636) in view of Yamazaki (Paper #20060911; US Pub.No.2003/0004834).

Hudda teaches all of the above as noted under the 102(b) rejection and teaches a) assigning a confirmation code to a user to indicate the user has made a purchase, b) using confirmation codes to indicate the user is authorized to receive a service, c) the user presenting the user code to a representative when claiming the service, and d) providing the service to the user upon user's presentation of the code in claiming the service. Hudda, however, does not disclose marking, at the service control system, the confirmation code as claimed to prevent future utilization of said confirmation code to claim said purchased service; downloading a database of a plurality of valid unique confirmation codes corresponding to purchased services to a local control system from a service control system, and comparing said confirmation code presented by the user to the codes at said database. Yamazaki teaches a shopping method, including an authentication unit, that a) assigns a confirmation code to a user to indicate the user has made a purchase, b) uses confirmation codes to indicate the user is authorized to

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receive a service, c) includes the user presenting the user code to a representative when claiming the service, and d) provides the service to the user upon user's presentation of the code in claiming the service. Yamazaki further teaches marking, at the service control system, the confirmation code as claimed to prevent future utilization of said confirmation code to claim said purchased service; downloading a database of a plurality of valid unique confirmation codes corresponding to purchased services to a local control system from a service control system, and comparing said confirmation code presented by the user to the codes at said database (see at least page 10 para.0191, and page 11 para.0216-0217). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Hudda to include marking, at the service control system, the confirmation code as claimed to prevent future utilization of said confirmation code to claim said purchased service; downloading a database of a plurality of valid unique confirmation codes corresponding to purchased services to a local control system from a service control system, and comparing said confirmation code presented by the user to the codes at said database, as taught by Yamazaki, in order to ensure that the user is authentic and is entitled to the service thereby greater use of the method by ensuring the reliability and security of commerce using the system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All references pertain to the use of SMS/MMS messaging in transactions.

- Gobburu; US Pub. No. 2002/0060246 (May 23, 2002): Teaches transmission of various product information using SMS/MMS and transaction databases either resident on the device or stored remotely.
- Immonen; US Pub. No. 2002/0077993 (June 20, 2002): Teaches conduct of wireless payments in which bearers include SMS messages and receipts are transmitted by SMS.
- Yeh; US Pub. No. 2002/0143995 (Oct. 2, 2002): Teaches use of both email and SMS transmissions in conducting translations, and also teaches the translation of transaction information back and forth between each messaging medium.
- Balani; US Pub. No. 2003/0007464 (Jan. 9, 2003): Teaches use of SMS and MMS in searching for and matching clients with items to buy based on criteria, teaches use of SMS and MMS in bidding on and buying items.
- Steinberg; US Pub. No. 2004/0006538 (Jan. 8, 2004): Teaches methods and systems for SMS transactions on wireless devices. Includes auction functionality.
- Ronaghi; US Pub. No. 2004/0103040 (May 27, 2004): Teaches providing legal services and transactions therein via SMS/MMS.

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- Sivula; US Patent No. 6,907,239 (June 14, 2005): Teaches charging for telecommunication download services.
- Wesby; US Patent No. 7,027,808 (April 11, 2006): Teaches asset management in diverse product group.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


This application contains claims 16-28 drawn to inventions nonelected without traverse in the reply filed on June 29, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine
Patent Examiner
May 6, 2007


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